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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,237	08/26/2003	Jerromy Laverne Johnson	11857.67	6004
59075	7590	05/19/2009	EXAMINER	
USAA (WW)			RAJ, RAJIV J	
Attn: Patent Counsel			ART UNIT	
9800 Fredericksburg Road			PAPER NUMBER	
San Antonio, TX 78288			3686	
			MAIL DATE	
			DELIVERY MODE	
			05/19/2009	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,237

Applicant(s)

JOHNSON ET AL.

Examiner

RAJIV J. RAJ

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15, 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 13, 2009 has been entered.

Status of Claims

2. Claims 1, 9 & 15 have been amended.
3. Claims 1-9, 11-15 & 17-20 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 & 9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if and how the "*determining*" step is derived from the "*comparison*" step.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 has in its preamble *"A computer-readable medium comprising computer readable instructions"*. Claim 9, as currently written, does not have the functional descriptive material (a program) as structurally and functionally interrelated to the medium. Instead, claim 9 should be directed to an **executable** computer program that is **tangibly embodied** on a computer readable medium. In addition, the amendments to claim 9's with respect to this rejection, are made in the preamble, and therefore do not cure the stated issue with claim 9.
8. Claims 1-8 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims (1-8) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-5, 7-15 & 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rieker (US 5832447) (hereinafter Rieker) in view of Bosco et al. (US 5191522)

(hereinafter Bosco).

Claim 1

Rieker as shown, discloses the following limitations:

- *providing a plurality of interrelated tables;* (see at least Rieker Fig:9 A-D & related text)

- *providing a first key reference in first table, the first key reference identifying a first specific group of the variables;* (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)
- *matching the first key reference to a second table,* (see at least Rieker Fig:7B Item:266 & related text)
- *the first key reference identifying a second specific group of variables and a plurality of additional key references;* (see at least Rieker Fig:9B Item:400-466 & related text)
- *accessing the second table using the first key reference to retrieve the first deductible;* (see at least Rieker Column:9 Lines:45-67 Column:10 Lines:1-67)

Rieker does not disclose the following limitations, however Bosco, as shown does:

- *providing a plurality of policy variables for each table;* (see at least Bosco Column:8 Lines:42-51)
- *matching the plurality of additional key references to a plurality of respective additional tables, the additional key references identifying a plurality of additional specific groups of variables;* (see at least Bosco Column:9 Lines:10-18 Lines:20-50)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker. One of ordinary skill in the art would have added these features into Rieker with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Rieker & Bosco do not disclose the following limitations, however, Ryan as shown does:

- *comparing the first deductible with a second deductible determining a deductible amount for a related policy renewal based on the comparison of the first deductible with the second deductible;* (see at least Ryan Claims:1-4)

It would have been obvious to one of ordinary skill in the art to add the features of Ryan into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation to provide an improved invention for assessing, comparing and selecting insurance products and variables. (see at least Ryan Column:5 Lines:16-67, Column:6 Lines:1-67, Column:7 Lines:1-12)

- *the second table including a first deductible;* (Design Choice)

The second table including a first deductible is a design that is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and "Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims." (See, In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947))

Claim 2

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 1. Rieker further discloses the following limitation:

- *in the first table, providing a geographical variable, a transaction variable and an effective policy date variable;* (see at least Rieker Fig:10 A-B & related text)

Claim 3

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 2.

Bosco further discloses the following limitation:

- *in the second table, providing a first deductible variable and a second deductible variable;* (see at least Bosco Column:7 Lines:58-62, column:9 Lines43-45, Fig:10 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Claim 4

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 3.

Bosco further discloses the following limitation:

- *in one of the additional tables, providing variables distinguishing deductibles available to the policies;* (see at least Bosco Column:11 Lines:42-59)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more

efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Claim 5

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 3.

Bosco further discloses the following limitation:

- *in another of the additional tables, providing variables identifying change from the first deductible to the second deductible;* (see at least Bosco Column:7 Lines:58-62)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Claim 7

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 1.

Bosco further discloses the following limitation:

- *another table controls each variable used to distinguish a first deductible variable from a second deductible variable;* (see at least Bosco Column:7 Lines:58-62& Column:9 Lines:43-45)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more

efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Claim 8

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 7.

Rieker further discloses the following limitation:

- *the additional tables respectively provide variables distinguishing deductibles available to the policies and identifying change from the first deductible to the second deductible* (see at least Rieker Fig:7G Items:366-370 & related text)

Claim 9

Rieker as shown, discloses the following limitations:

- *providing a plurality of interrelated tables including a first table, a second table, and a third table;* (see at least Rieker Fig:9 A-D & related text)
- *wherein the variables in the first table include a geographical variable, a transaction variable and an effective policy date variable;* (see at least Rieker Fig:10 A-B & related text)
- *providing a first key reference in first table, for identifying a first specific group of the variables;* (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)
- *accessing the second table using the first key reference to retrieve the first deductible;* (see at least Rieker Column:9 Lines:45-67 Column:10 Lines:1-67)

Rieker does not disclose the following limitations, however Bosco, as shown does:

- *providing a plurality of policy variables in each table; (see at least Bosco Column:8 Lines:42-51)*
- *wherein the variables in the second table include first deductible variables and second deductible variables; (see at least Bosco Column:7 Lines:58-62, Fig:10 & related text)*
- *wherein the variables in the third table distinguishes deductibles available to the policies; (see at least Bosco Column:11 Lines:42-59)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker. One of ordinary skill in the art would have added these features into Rieker with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Rieker & Bosco do not disclose the following limitations, however, Ryan as shown does:

- *comparing the first deductible with a second deductible; determining a deductible amount for a related policy renewal based on the comparison of the first deductible with the second deductible; (see at least Ryan Claims:1-4)*

It would have been obvious to one of ordinary skill in the art to add the features of Ryan into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation to provide an improved invention for assessing, comparing and selecting insurance products and variables. (see at least Ryan Column:5 Lines:16-67, Column:6 Lines:1-67, Column:7 Lines:1-12)

Claim 11

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 9.

Rieker further discloses the following limitation:

- *the first key reference identifies a first specific group of variables (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)*

Claim 12

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 11.

Rieker further discloses the following limitation:

- *the first key reference is matched to the second table (see at least Rieker Fig:7B Items:266 & related text)*

Claim 13

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 12.

Rieker further discloses the following limitation:

- *the first key reference identifies a second specific group of variables and a plurality of additional key references (see at least Rieker Fig:9B Items:400-466 & related text)*

Claim 14

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 13.

Bosco further discloses the following limitation:

- *the plurality of additional key references are matched to a plurality of respective additional tables; (see at least Bosco Column:9 Lines:10-18)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Claim 15

Rieker as shown, discloses the following limitations:

- *a storage device storing a program;* (see at least Rieker Fig:3 Items:100, 150B, Fig:4 Items:172 & related text)
- *a processor coupled to the storage device* (see at least Rieker Fig:3 Items:100, 150B, Fig:4 Items:172 & related text)
- *operative with the program for processing data in a plurality of interrelated tables;* (see at least Rieker Fig:300 Items:100,110 Fig:9 A-D & related text)
- *the variables in a first table including a geographical variable, a transaction variable, an effective policy date variable;* (see at least Rieker Fig:10 A-B & related text)
- *and a first key reference;* (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)

Rieker does not disclose the following limitations, however Bosco, as shown does:

- *a plurality of policy variables in each table;* (see at least Bosco Column:8 Lines:42-51)

- *the variables in a second table including first deductible variables and second deductible variables, being accessed using the first key reference; (see at least Bosco Column:7 Lines:58-62, Column:8 Lines:40-51, Fig:10 & related text)*
- *the variables in a further table distinguishing deductibles available to the policies; (see at least Bosco Column:11 Lines:42-59)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker. One of ordinary skill in the art would have added these features into Rieker with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Rieker & Bosco do not disclose the following limitations, however, Ryan as shown does:

- *deductible variables determine a deductible amount for a related policy renewal based on the comparison of the first deductible with the second deductible; (see at least Ryan Claims:1-4)*

It would have been obvious to one of ordinary skill in the art to add the features of Ryan into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation to provide an improved invention for assessing, comparing and selecting insurance products and variables. (see at least Ryan Column:5 Lines:16-67, Column:6 Lines:1-67, Column:7 Lines:1-12)

Claim 17

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 15.

Rieker further discloses the following limitation:

- *the first key reference identifies a first specific group of variables; (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)*

Claim 18

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 17.

Rieker further discloses the following limitation:

- *the first key reference is matched to the second table (see at least Rieker Fig:7B Items:266 & related text)*

Claim 19

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 18.

Rieker further discloses the following limitation:

- *the first key reference identifies a second specific group of variables and a plurality of additional key references (see at least Rieker Fig:9B Items:400-466 & related text)*

Claim 20

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 19.

Bosco further discloses the following limitation:

- *the plurality of additional key references are matched to a plurality of respective additional tables; (see at least Bosco Column:9 Lines:10-18)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

12. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker in view of Bosco in further view of Garrett et al. (US 5325291) (hereinafter Garrett).

Claim 6

The combination of Rieker/Bosco/Ryan disclose all of the limitations of claim 1. Garrett further discloses the following limitation:

- *the first table controls an initial placement of the first key reference on the second table;* (see at least Garrett Fig:5,6 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco/Ryan. One of ordinary skill in the art would have added these features into Rieker/Bosco/Ryan with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

Response to Arguments

13. Applicant's arguments received on 09 April 2009 have been fully considered but they are not persuasive. Applicants' arguments will be addressed herein below in the order in which they appear in the response filed 09 April 2009.
14. In response to applicant's argument that "(1) *accessing a table using a key reference in another table to retrieve a first deductible; (2) comparing the first deductible with a second deductible; and (3) determining a deductible amount for a related policy renewal based on the comparison of the first deductible with the second deductible.*" fails to be addressed, Examiner points out that this is not the exact claim language, and further this claim language is new and/or amended which is why it was not addressed in the previous Office Action. However, this claim language is addressed by the cited prior art in the current Office Action.
15. In response to applicant's argument that Rieker, Bosco, Ryan & Garrett is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).
16. As per claims 2-8 applicant makes arguments based on dependency on claim 1, and are rejected for on the same grounds
17. As per claims 9 & 15 applicant makes the same general arguments found in claim 1, and are rejected for on the same grounds

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **(571) 270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jerry O'Connor** can be reached at **571.272.6787**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to **(571) 273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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Date: 05/10/09
/RJR/ Patent Examiner Art Unit 3686

/Gerald J. O'Connor/
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